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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,968	02/13/2002	Heinrich Wieland	38891.00100	6225

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EXAMINER

HANLEY, SUSAN MARIE

ART UNIT	PAPER NUMBER
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1651

MAIL DATE	DELIVERY MODE
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10/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/049,968

Applicant(s)

WIELAND ET AL.

Examiner

Susan Hanley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's remarks filed 6/4/07 are acknowledged.

Claims 54-69 are pending.

Response to Arguments

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

Claims 54-56, 58, 59, 61-64 and 67 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-7 of U.S. Patent No. 6,071,526.

Applicant argues that instant claim 54 recites the step of "identifying a subject suffering from a collagen deficient condition" and that the '526 patent does not teach this limitation. Applicant asserts that the examiner has not pointed out where this disclosure can be found.

In response to applicant's argument that the '526 patent does not teach the step of identifying a subject suffering from a collagen deficient condition, an identifying step can be an entirely mental step. In instances wherein the step of "of identifying a subject suffering from a collagen deficient condition" is entirely a mental step, the claimed processes are entirely indistinguishable from the '526 patent method because all of the outwardly visible steps in the claimed process are the same steps as carried out by the '526 patent. That is, since the '526 patent teaches treating (e.g., a physical step such as applying the treatment agent) skin wherein the

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treatment agent is absorbed by the skin and passes through the cutis and into the subcutis. Collagen present in the cutis, just like collagen in the underlying subcutis, would inherently experience the same effect of the agent. hydrolyzes the same starting material with the same enzyme to result in a product having the same degree of hydrolysis.

Claim Rejections - 35 USC § 102

Claims 54-69 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schmidt et al. (WO 97/36570; item BG in the IDS filed 10/8/02).

Applicant recaps the relationships among US 6,071,526, which is a divisional of US 4,945,109, both of which claim priority to DE 19612748. Applicant states that the '570 publication also claims priority to the German '748 application. Applicant argues that instant claim 54 recites the step of "identifying a subject suffering from a collagen deficient condition" and that the '570 publication does not teach this limitation. Applicant asserts that the examiner has not pointed out where this disclosure can be found.

Responding to Applicant's recap of the relationships among the cited patents, applications and publications, neither WO 97/36570, US 6,071,526, US 4,945,109 nor DE 19612748 are related as parents, children or foreign priority documents to the instant application or its priority documents. Thus, as Applicant correctly pointed out, the '570 and '526 patents are not eligible as prior art under 35 USC 102(e). However, WO 97/36570 is not a US patent and not subject to the 102(e) statute. It is eligible as prior art under 35 USC 102(b) since its publication date, 21 March 1996, predates the effective filing date of this application by more than one year.

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In response to applicant's argument that Schmidt et al. (the '570 publication) do not teach the step of identifying a subject suffering from a collagen deficient condition, an identifying step can be an entirely mental step. In instances wherein the step of "of identifying a subject suffering from a collagen deficient condition" is entirely a mental step, the claimed processes are entirely indistinguishable from the Schmidt et al. method because all of the outwardly visible steps in the claimed process are the same steps as carried out by Schmidt et al. That is, since Schmidt et al. teach treating (e.g., a physical step such as applying the treatment agent) skin wherein the treatment agent is absorbed by the skin and passes through the cutis and into the subcutis. Collagen present in the cutis, just like collagen in the underlying subcutis, would inherently experience the same effect of the agent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Hanley whose telephone number is 571-272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

SANDRA E. SAUCIER
PRIMARY EXAMINER



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Hanley
Patent Examiner
AU 1651

SANDRA E. SAUCIER
PRIMARY EXAMINER

